

Appl. No. : 10/063,736
Filed : May 8, 2002

REMARKS

Applicants have cancelled Claims 4-5, 14 and 16-31 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Applicants thank the Examiner for his review of the instant application. Applicants acknowledge the Examiner's grant of priority to August 24, 2000. Applicants also acknowledge the withdrawal of: the rejection of Claims 1-14 and 16-20 under 35 U.S.C. § 112, second paragraph, as being indefinite; the rejection of Claims 1-6, 9, 10 and 11-14 under 35 U.S.C. § 112, first paragraph, as lacking written description with respect to "extracellular domain" and "signal peptide"; the rejection of Claims 6 and 11-13 under 35 U.S.C. § 112, first paragraph, scope of enablement with respect to "extracellular domain" and "signal peptide"; the rejection of Claims 1-20 under 35 U.S.C. § 101 as lacking utility; the rejection of Claims 1-20 under 35 U.S.C. § 112, first paragraph, as lacking enablement for lack of utility. Applicants also acknowledge that the Examiner has withdrawn the rejection of Claims 1-20 under 35 U.S.C. § 102(b) as anticipated by Lal *et al.* (WO200000610A2) in light of the instant application receiving the priority date of August 24, 2000.

Claims 6 and 11-13 are presented for examination. The rejections to the presently pending claims are respectfully traversed.

Rejection under 35 U.S.C. §112, first paragraph – Enablement

The PTO has maintained the rejection of Claims 4, 5, 14 and 16-31 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention.

Applicants maintain that the rejected subject matter is enabled. However, in the interest of advancing prosecution of the instant application, Applicants have canceled Claims 4, 5, 14 and 16-31, rendering the rejection moot.

Rejection under 35 U.S.C. §112, first paragraph – Written Description

The PTO has maintained the rejection of Claims 4, 5, 7, 14 and 16-31 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in

Appl. No. : 10/063,736
Filed : May 8, 2002

such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the invention.

Applicants maintain that the rejected subject matter is adequately described. However, in the interest of advancing prosecution of the instant application, Applicants have canceled Claims 4, 5, 14, and 16-31, and Claim 7 was canceled in a previous Amendment, rendering the rejection moot.

Rejection under 35 U.S.C. §102(e) – Anticipation

The PTO rejects Claims 4-6, 12-14 and 16-31 as anticipated under 35 U.S.C. § 102(e) by Lal *et al.* (WO200000610 A2, January 2000) (hereinafter Lal), which was filed on June 25, 1999.

The M.P.E.P. §706.02(f)(1), “Examination Guidelines for Applying References Under 35 U.S.C. § 102(e)” makes clear in paragraph I.(C)(3)(b) that “if the international application has an international filing date prior to November 29, 2000, ... for WIPO publication directly resulting from international applications under PCT Article 21(2), **never apply these references under 35 U.S.C. § 102(e).**” (emphasis added); *see also M.P.E.P. §706.02(f)(1) Example 6*. As the June 25, 1999 filing date of Lal is prior to November 29, 2000, Lal is not available as prior art under 35 U.S.C. § 102(e). Applicants therefore respectfully request that the rejection under 35 USC §102(e) be withdrawn.

Appl. No. : 10/063,736
Filed : May 8, 2002

CONCLUSION

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Aug. 18, 2005

By: AnneMarie Kaiser

AnneMarie Kaiser
Registration No. 37,649
Attorney of Record
Customer No. 30,313
(619) 235-8550

1804355
070705